

REMARKS

Applicants have carefully reviewed the Office Action dated January 5, 2006, and respectfully request reconsideration in view of the foregoing amendments and the following remarks.

Claims 1, 5 and 15 have been amended and Claims 14 and 16 have been canceled. Support for the range of hydrophilic groups is found at page 4, lines 15-18 and support for the isocyanate-reactive groups is found at page 4, lines 28-29. The remaining amendments will be discussed with regard to the following rejections.

Restriction to one of the following inventions has been required under 35 USC 121:

- I. Claims 1-7 and 12-17, drawn to a composition, classified in Class 525, subclass various;
- II. Claims 8-9 and 11, drawn to a method of coating, classified in Class 427, subclass 385.5; and
- III. Claim 10, drawn to an article, classified in Class 411.1+.

The Examiner contends that the Group I and II inventions are related as product and process of use as set forth in MPEP 806.05(h). The Examiner contends that the product or composition as claimed can be used in a materially different process, such as one in which the composition is extruded into a free-standing sheet.

The Examiner contends that the Group II and III inventions are related as process of making and product made as set forth in MPEP 806.05(f). The Examiner contends that the product or article as claimed can be made by a lamination process instead of a coating process.

In accordance with 37 CFR 1.143 Applicants affirm their provisional election, **with traverse**, to prosecute the Group I invention, containing Claims 1-7 and 12-17. Applicants are not traversing the restriction requirement.

Claims 1-7 and 12-17 have been rejected under 35 USC 112, second paragraph, as being indefinite for the following reasons.

- A. "One-component" is unclear because there are two components I) and II) and Applicant's specification calls for the addition of other binders.

Applicants submit that the term one-component is a term of art that means that the components are not reactive with each other under ambient conditions and, thus, can be stored in one container under normal storage conditions. In the present application this is possible because the isocyanate groups of polyisocyanate B) are blocked such that they do not react with water or polyurethane A) under ambient conditions.

- B. "Preferably" in Claims 5 and 15 is indefinite because it is unclear which range "n" is limited to.

Applicants submit that this rejection has been overcome by amending "n" in Claim 5 to a range of 0 to 3 and amending "n" in Claim 15 to a range of 1 to 2.

In view of the preceding amendments and remarks, it is submitted that the subject claims are definite and in compliance with 35 USC 112, second paragraph. Accordingly, withdrawal of this rejection is requested.

Claims 1-8 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 12, 13, 14, and 15 of copending Application No. 10/458,119. The Examiner contends that the method disclosed in instant Claims 1-8 is obvious over the method of Claims 12-15 of the copending application when the composition of Claims 2-9, 16, 17 and 18 is used.

Applicants submit that this rejection has been overcome by filing the attached terminal disclaimer. Accordingly, withdrawal of this rejection is requested.

Claims 1-7 and 12-17 have been rejected under 35 USC 102(b,e) as being anticipated by or, in the alternative, under 35 USC 103(a) as being obvious over U.S. Published Application No. 2002/0165334 to Melchior et al. The Examiner contends that the reference discloses a hydrophilic polyurethane polyol having a hydroxyl value of as low as 16.5, which corresponds to 0.29 mmol OH/g polymer.

Applicants traverse this rejection in view of the amendment to Claim 1 to require the polyurethane to contain 0 to 0.25 mmol/g of groups containing Zerewitinov-active hydrogen atoms. In view of this amendment it is submitted that the claims are not anticipated by Melchior et al. In addition, it is submitted that the claims are not rendered obvious because Melchior et al requires the waterborne coating composition to contain at least one polyol having urethane groups. The

presence of hydroxyl groups is considered to be critical by Melchior et al. Therefore, there would be no motivation to remove the polyol from the composition based on the teachings of the reference.

For the preceding reasons it is submitted that Melchior et al does not anticipate or render obvious the subject claims. Accordingly, withdrawal of this rejection is requested.

Claims 1-7 and 12-17 have been rejected under 35 USC 102(b,e) as being anticipated by or, in the alternative, under 35 USC 103(a) as being obvious over U.S. Patent 5,521,247 to Dobler et al.

Applicants submit that this rejection has also been overcome by the amendments to Claim 1 to limit the claimed resins to those having 0 to 0.25 mmol/g of isocyanate-reactive groups. The polyester resins of Dobler et al (note the Abstract) have an OH number of at least 50, which corresponds to more than the amount of isocyanate-reactive groups allowed by the subject claims. In addition, it is submitted that the claims are not rendered obvious because it would not be obvious to reduce the hydroxyl number of the polyesters required by Dobler et al.

For the preceding reasons it is submitted that Dobler et al does not anticipate or render obvious the subject claims. Accordingly, withdrawal of this rejection is requested.

Claims 1-4, 7, 12, 13 and 17 have been rejected under 35 USC 102(b,e) as being anticipated by or, in the alternative, under 35 USC 103(a) as being obvious over U.S. Patent 5,552,494 to Vogt-Birnbrich. The Examiner contends that the reference discloses aqueous coatings containing hydrophilic polyurethanes and crosslinkers such as blocked polyisocyanates.

Applicants traverse this rejection in view of the amendment to Claim 1 to limit the scope of the isocyanate-reactive groups. The polyurethanes of Vogt-Birnbrich require the presence of CH-acidic groups (note the Abstract). It is also disclosed that the CH-acidic groups are reactive with the polyisocyanate crosslinkers. Because the CH-acidic groups are outside the scope of the isocyanate-groups set forth for polyurethane component A), It is submitted that Vogt-Birnbrich fails to anticipate or render obvious the subject claims. Accordingly, withdrawal of this rejection is requested.

Claims 1-4, 7, 12, 13 and 17 have been rejected under 35 USC 102(b,e) as being anticipated by or, in the alternative, under 35 USC 103(a) as being obvious over U.S. Patent 5,569,707 to Blum et al. The Examiner contends that the reference discloses aqueous coatings containing polyesterurethane polyols and that blocked polyisocyanates may be used as the crosslinker.

Applicants traverse this rejection because Blum et al fails to disclose the hydrophobic polyisocyanates required by the subject claims. Blum et al discloses (column 7, lines 16-19) amino resins, blocked polyisocyanates which may be hydrophilically modified and polyisocyanates having free isocyanate groups which may be hydrophilically modified. In the examples at column 13 only hydrophilically modified polyisocyanates (both blocked and unblocked) and amino resins are used as crosslinking agents. Because Blum et al is silent regarding hydrophobic, blocked polyisocyanates, it is submitted that this reference fails to anticipate or render obvious the subject claims. Accordingly, withdrawal of this rejection is requested.

The foregoing is believed to be a complete response to the Office Action dated January 5, 2006, and in view of the preceding amendments and remarks, a Notice of Allowance is respectfully requested.

Respectfully submitted,

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